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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of:	)	
<b>Jay Paul Drummond, et al.</b>	)	
	)	
Serial No.: 09/077,337	)	Art Unit: 3624
	)	
Confirmation No.: 5900	)	
	)	
Filed: May 27, 1998	)	Patent Examiner:
	)	<b>James S. Bergin</b>
Title: Automated Banking Machine	)	
Apparatus and System	)	

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Commissioner for Patents  
P. O. Box 1450  
Alexandria, VA 22313-1450

**SECOND SUPPLEMENTAL BRIEF OF APPELLANTS  
PURSUANT TO 37 C.F.R. § 1.192**

Sir:

The Appellants hereby request reinstatement of the appeal pursuant to 37 C.F.R. § 1.193(b)(2). The Appellants hereby submit their Second Supplemental Appeal Brief pursuant to 37 C.F.R. § 1.192, in triplicate, concerning the above-referenced Application.

## **REAL PARTY IN INTEREST**

The Assignee of all right, title and interest to the above-referenced Application is Diebold, Incorporated, an Ohio corporation.

## **RELATED APPEALS AND INTERFERENCES**

Appellants believe that there are no related appeals or interferences pertaining to this matter.

## **STATUS OF CLAIMS**

Claims 1-54 are pending in the Application. Claims 1-30, 32-34, 36-37, 39-40, 42-43, and 46-47 have been withdrawn from consideration.

Claims 31, 35, 38, 41, 44-45, and 48-54 were rejected pursuant to 35 U.S.C. § 103(a) as being unpatentable over the Los Angeles Times article "Trade It Yourself Bank Machines Make A Debut" (hereinafter "LA Times") in view of either the Infoworld article "TP-Monitor Vendors Spin Web Features" (hereinafter "Infoworld") or Anderson et al. (US 5,706,442) (hereinafter "Anderson").

These rejections were the only rejections present in the Office Action ("Action") dated July 15, 2003. Appellants appeal each claim rejection, inclusive.

## **STATUS OF AMENDMENTS**

No final rejection has been made. However, claims have been rejected five times. Therefore, no amendments to the claims were requested to be admitted after a final rejection.

### Additional Comments

A portion of the history of this application is as follows:

1. 11/27/96 Provisional Application 60/031,956 filed.
2. 11/25/97 PCT/US97/21422 filed.
3. 05/27/98 Present Application filed, claiming priority to the provisional.
4. 02/17/00 FIRST non-final rejection.
5. 04/07/00 Applicants' Response.
6. 04/24/01 Restriction.
7. 05/23/01 Applicants' Response with a declaration swearing behind 07/27/96.
8. 06/19/01 SECOND non-final rejection.
9. 07/10/01 Declaration swearing behind 02/16/96.
10. 07/30/01 Notice of Appeal.
11. 09/18/01 Appeal Brief.
12. 01/31/02 THIRD non-final rejection. Acknowledgment that the declaration is effective to swear behind 02/16/96.
13. 03/11/02 Supplemental Appeal Brief.
14. 10/01/02 Examiner initiated Suspension. No time period was set. The reason given for the suspension was that the outcome of a pending Interference (of which Appellants were not a part) had material bearing on the patentability of the Application.
15. 04/01/03 Appellants request an Examiner's Answer in light of the expiration of the maximum 6 month suspension period.

16. 06/17/03 FOURTH non-final rejection. Relies on documents previously available prior to the suspension. Alleges that the previously deemed effective declaration is now deemed not effective.
17. 07/15/03 FIFTH non-final rejection (supplemental).

As the record shows, Appellants have received five non-final rejections, including one after an Appeal Brief was filed and another after a Supplemental Appeal Brief was filed. In light of the Office's continuing habit of non-final rejections, Appellants reserve the right to further expound on the issues after an Examiner's Answer has actually been written. That is, until the Office ceases causing undue burden to Appellants, it would be unreasonable to expect Appellants to explain the issues in fine detail.

A Petition for Withdrawal of a Restriction Requirement was filed by Appellants on July 10, 2001. As of the writing of this Supplemental Appeal Brief, Appellants had not yet received a response by the Office in regard to their Petition. Nevertheless, upon this application coming under the jurisdiction of the Board, Appellants plan to request (without prejudice) that the Petition be withdrawn. Thus, no petitions would be outstanding before the Board. Appellants plan to file a subsequent separate paper requesting withdrawal of the Petition upon notice that this application is before the Board. Appellants respectfully continue to disagree with the Restriction Requirement. The reason for withdrawal of the Petition is to prevent still further unnecessary prosecution delay by the Office (e.g., additional non-final rejections). Appellants reserve the right to rejoinder. MPEP § 821.04 (Eighth Edition, August 2001; Rev. 1, Feb. 2003). Appellants also reserve the right to file one or more applications (e.g., a divisional application) relating to any restricted claim.

Appellants acknowledge the Office's admission that the Semple-based rejections have been withdrawn because of the arguments presented in the Supplemental Appeal Brief filed March 11, 2002. Of course, each of the several different rejections prior to the Semple-based rejections had already been withdrawn by the Office. As shown in more detail herein, Appellants' claims are also allowable over the current grounds for rejection. The Offices' repeated presentation of non-final rejections is improper, and reflective of the impropriety of all the previous (withdrawn) rejections and the rejections currently pending. Thus, Appellants respectfully request reinstatement of their appeal pursuant to 37 C.F.R. § 1.193(b)(2).

## **SUMMARY OF INVENTION**

### Overview of an exemplary form of the Invention

An exemplary form of the invention is directed to an automated banking machine (e.g., an ATM) including a computer (34) which has a browser (76) or other HTML document handling software operating therein (e.g., Figure 2). The ATM (12) also includes a sheet dispenser, such as a currency note dispenser (42). In the exemplary form of the invention the ATM is connected to a local network or a wide area network (18) (e.g., Internet) and can operate to receive one or more HTML documents. The received HTML document(s) can include one or more instructions that are processed by the browser. The ATM computer can operate in response to instructions included in the received HTML documents to control the currency dispenser to dispense currency notes. Thus, the ATM can dispense currency in response to a markup language document(s).

In the exemplary form of the invention the ATM can also include a card reader (38) in operative connection with the computer. The card reader can read indicia on a customer's card.

The address of accessible HTML document(s) can be determined from the card indicia. The card indicia can correspond to a uniform resource locator ("URL") address. The computer can operate, responsive to the indicia read by the card reader, to cause the browser to receive HTML documents (which include instructions which operate devices in the ATM, such as dispense instructions).

### **CONCISE STATEMENT OF THE ISSUES PRESENTED FOR REVIEW**

The questions presented in this appeal are whether Appellants' claims 31, 35, 38, 41, 44-45, and 48-54 are unpatentable under 35 U.S.C. § 103(a) over LA Times in view of either Infoworld or Anderson.

### **GROUPING OF CLAIMS**

No groups of claims stand or fall together. Each of Appellants' claims 31, 35, 38, 41, 44-45, and 48-54 recite at least one element or combination of elements not found or suggested in the cited references, which patentably distinguishes the claims.

Every claim recites additional features of the invention which distinguishes the claim over every other pending claim.

The rejected claims include six independent claims (claims 31, 35, 38, 41, 44, and 51). Claim 45 depends from claim 44. Claim 48 depends from claim 31. Claim 49 depends from claim 35. Claim 50 depends from claim 38. Claims 52-54 depend from claim 51. All of the rejected claims 31, 35, 38, 41, 44-45, and 48-54 are reproduced in the Appendix.

## ARGUMENT

### The Applicable Legal Standards

Before a claim may be rejected on the basis of obviousness pursuant to 35 U.S.C. § 103, the Patent Office bears the burden of establishing that all the recited features of the claim are known in the prior art. This is known as *prima facie* obviousness. To establish *prima facie* obviousness, it must be shown that all the elements and relationships recited in the claim are known in the prior art. If the Office does not produce a *prima facie* case, then the Appellants are under no obligation to submit evidence of nonobviousness. MPEP § 2142 (Eighth Edition, August 2001; Rev. 1, Feb. 2003).

The teaching, suggestion, or motivation to combine the features in prior art references must be clearly and particularly identified in such prior art to support a rejection on the basis of obviousness. It is not sufficient to offer a broad range of sources and make conclusory statements. *In re Dembiczak*, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999).

Even if all of the features recited in the claim are known in the prior art, it is still not proper to reject a claim on the basis of obviousness unless there is a specific teaching, suggestion, or motivation in the prior art to produce the claimed combination. *Panduit Corp. v. Denison Mfg. Co.*, 810 F.2d 1561, 1568, 1 USPQ2d 1593 (Fed. Cir. 1987). *In re Newell*, 891 F.2d 899, 901, 902, 13 USPQ2d 1248, 1250 (Fed. Cir. 1989).

The evidence of record must teach or suggest the recited features. An assertion of basic knowledge and common sense not based on any evidence in the record lacks substantial evidence support. *In re Zurko*, 258 F.3d 1379, 59 USPQ2d 1693 (Fed. Cir. 2001).

A determination of patentability must be based on evidence of record. *In re Lee*, 277 F.3d 1338, 61 USPQ2d 1430 (Fed. Cir. 2002).

It is respectfully submitted that the Action from which this appeal is taken does not meet these burdens.

#### **The LA Times Article**

The LA Times article is directed to Citibank using ATMs to offer brokerage services. Citibank uses a "specially designed" ATM that keeps the brokerage services "separate" from the banking services via different menus. One menu is for banking and another menu is for brokerage services. LA Times is silent as to the (small) number of ATMs capable of providing brokerage services. However, the system structure currently limits ATMs to only geographical locations in New York, Chicago, and Miami.

#### **The Infoworld Article**

The Infoworld article is directed to a TP monitor called "Top End." It is well known that a "TP" monitor is an abbreviation for a "transaction processing" monitor. A plethora of information on TP monitors is available, including information which may be found via the Internet. A TP monitor is a program that monitors or tracks a transaction as it passes from one stage in a process to another, including across different computer systems. The TP monitor can provide transaction and data integrity by ensuring that each tracked system transaction gets processed to completion or is otherwise completely rolled back. Thus, for example, a TP monitor can make sure that groups of updates that are supposed to take place together actually do



all take place, or otherwise none take place. A TP monitor may also be useful in balancing system loads and in recovery from system failures. For example, a TP monitor may be used to monitor whether a message sent from a sending application program was successfully transmitted and received by a receiving application. In the event of a failure as determined by the TP monitor, the failed message can be either resent or switched over to a process on another node.

Infoworld teaches that Top End is "middleware" software that lets users deploy point-of-sale applications. Top End is apparently applicable to tracking transactions conducted using credit cards at ATMs and electronic cash registers to be sure they are properly processed. A Web-specific version of Top End newly written at the time of the article has client code written as a set of Java class libraries. The Java client running in the cash register or ATM downloads the transaction data by establishing a direct link to a Web browser that runs at the Top End remote back-end system. The back-end system records and stores the data about the transactions. In this way, the client directly connects to the Top End back office (away from the cash register or ATM) through a (TCP/IP) connection. The Top End client can send transaction data from the cash register or ATM to the remote back-end system (which charges the customer's account for the transaction) to reduce the risk that the transaction is not properly processed.

### **The Anderson Reference**

Anderson is directed to a system for delivering financial information. Anderson's "Conductor" system is a sophisticated computer software system based on distributed system technology (col. 1, lines 56-57). The distributed system includes a Conductor system architecture network. The system works to provide timely financial information to users. The

system permits users to review activity and balances relating to their accounts. For example, the system permits a user to use a PC (col. 1, lines 52-54) to "access information regarding recent account activity or their account balances" (col. 1, lines 12-14) "so that users may review activity and balances" (col. 2, line 1). Anderson's financial information service system is capable of servicing (fulfilling) financial information requests (col. 5, lines 24-47; col. 6, lines 19-23). The information requests are related to the viewing of account information, such as recent debit card transactions (col. 5, lines 24-47). The requested financial information may be transmitted back to the user's PC (col. 1, lines 52-54; col. 5, lines 44-47). Anderson's service enables a user to check or verify their bill payments.

**(iii) 35 U.S.C. § 103**

Appellants traverse the rejections on the grounds that Appellants' claims recite features and relationships which are neither disclosed nor suggested in the cited art, and because there is no teaching, suggestion, or motivation cited so as to produce Appellants' invention. The features and relationships recited in Appellants' claims patentably distinguish over the applied references.

Appellants respectfully submit that none of the applied references, taken alone or in combination, disclose or suggest the features and relationships that are specifically recited in the claims. Additionally, even if it were somehow possible for the references to have disclosed certain features as alleged, it still would not have been obvious to have combined the references as alleged. Furthermore, even if it were somehow possible for the references to be combined as alleged, the resultant combination still would not have produced Appellants' claimed invention.

The Office has not made a *prima facie* showing of obviousness. Appellants respectfully submit the rejections are improper and should be withdrawn.

Appellants' remarks concerning the claim rejections in no way waive their rights to have the rejections relying on the applied reference stricken for the reasons presented herein.

### **The 37 C.F.R. § 1.131 Declaration**

The present invention is entitled to (and claims benefit of) the November 27, 1996 filing date of provisional application 60/031,956. Appellants filed a Declaration on July 10, 2001 pursuant to 37 C.F.R. § 1.131. The Declaration swears back prior to February 16, 1996, proving an actual reduction to practice of the invention prior to that date.

The Office has acknowledged in the record on many occasions that the Declaration was entered and was deemed effective to swear behind the February 16, 1996 date. For example, the Office Action (at page 2) dated January 31, 2002 states that "The previous 35 U.S.C. § 103(a) rejection . . . is revoked in view of applicant's 37 C.F.R. 1.131 Declaration filed 7/10/2001, in which declaration the applicant re-identifies the date of invention as sometime prior to February 16th, 1996."

For further example, the Declaration filed July 10, 2001 is substantially identical to the prior Declaration filed May 23, 2001, except for mention of the February 16, 1996 date and date of signature. The Office entered the prior Declaration and acknowledged (e.g., Interview Summary in the Office Action dated June 19, 2001) the effective earlier date set forth by the prior Declaration. Thus, by inference the Office again admitted that the Declaration filed July 10, 2001 was effective to swear behind the February 16, 1996 date.

The Action (from which this Second Supplemental Appeal Brief is submitted) now alleges that the Declaration is somehow insufficient. It is unclear how Appellants' 37 CFR. § 1.131 Declaration could be acknowledged on the record as effective by the Office on numerous occasions (through several Actions and over several years), then suddenly be deemed unacceptable. Appellants respectfully submit that the Declaration filed July 10, 2001 remains effective to swear behind the February 16, 1996 date. Appellants request the Board to rightfully grant the Declaration its due (and previously acknowledged) effectiveness. The effectiveness of the entered Declaration are part of the decision from which this appeal is taken (MPEP § 715.08).

Rebuttal of the Action's allegation regarding non-established diligence

The Action (page 2, paragraph numeral 3) alleges that "The evidence submitted is insufficient to establish diligence from a conception date prior to 7/27/1996 or 2/16/1996, to an actual reduction to practice date prior to 7/27/1996 or prior to 2/16/1996." The Appellants respectfully disagree with the Office's assessment of the Declaration. The Declaration shows evidence of actual reduction to practice of the invention prior to February 16, 1996. Because of this showing of actual reduction to practice, diligence is not an issue. Thus, the Action's remarks concerning diligence are without merit.

Reduction to Practice

The Declaration shows evidence of reduction to practice of the invention prior to February 16, 1996. The exhibits which are part of the Declaration show the actual making and proving of the capabilities of an automated banking machine receiving a markup language

document having a transaction instruction, and carrying out an automated banking machine transaction function responsive to the document.

For example, Exhibit A refers to an "approach to ATM transactions", "Use Internet technology to implement the ATM transaction flow", "Send transaction data. Get function command as some sort of Internet file. An encrypted/authenticated file transfer that specifies the function command stuff", "Could be done over the public Internet", "Bank is on Internet", and "The transaction flow, screen content, etc is not in the ATM. It is on the net."

Furthermore, Exhibit C (e.g., at upper right box) is related to a "transaction lead-through." It was known in the prior art to have an ATM machine with internal mechanical devices (e.g., a note dispenser mechanism) for use in performing a requested transaction function (e.g., a cash withdrawal request). Exhibit C (e.g., at upper right box) also shows the ability to "receive transaction command" files. Exhibit C (e.g., at upper right box) further shows a relationship of using "Internet technology" (e.g., HTML documents; and mentioned in Exhibit A) for carrying out a "transaction" function (e.g., note dispensing).

The Declaration shows that, prior to the date mentioned, the invention was completed in this country and reduced to practice (or alternatively there was reduced to practice a novel apparatus and/or method which would render the claimed invention obvious therefrom) the subject matter of at least one claim (e.g., claim 44). The Declaration contains facts showing a completion of the invention commensurate with the extent of the invention as claimed in at least one claim (e.g., claim 44). Therefore, the Appellants respectfully submit that the Declaration is legally sufficient to establish a reduction to practice. Additionally, with the showing of a reduction to practice of the subject matter of a (broad) independent claim (e.g., claim 44),

Appellants are also entitled to the date indicated in the Declaration for any additional (narrower) subject matter which would have been obvious to one having ordinary skill in the art from the invention reduced to practice (MPEP § 715.02).

Restoration of the Declaration to its previously acknowledged position of legal effectiveness as establishing a reduction to practice prior to February 16, 1996 is respectfully requested.

**The Declaration Is Effective To Swear Behind Infoworld**

The Infoworld article apparently has an effective date of July 1, 1996. Appellants' claims patentably distinguish over Infoworld. Nevertheless, as previously discussed, the Declaration filed on July 10, 2001 pursuant to 37 C.F.R. § 1.131, effectively establishes Appellants' reduction to practice prior to February 16, 1996. Thus, the Declaration is effective to swear behind Infoworld.

**The Claims Are Not Obvious Over  
LA Times in view of either Infoworld or Anderson**

In the Action claims 31, 35, 38, 41, 44-45, and 48-54 were rejected under 35 U.S.C. § 103(a) over LA Times in view of either Infoworld or Anderson. These rejections are respectfully traversed.

As previously discussed, the Declaration is effective to swear behind Infoworld. Furthermore, Appellants respectfully submit that all of the pending claims which the Office

contents are obvious from the subject matter reduced to practice (as established in the Declaration) are also allowable in the present Application (MPEP § 715.02).

The rejections are further not appropriate because the cited references neither disclose nor suggest the claimed invention.

**Claim 31**

Claim 31 is directed to an automated banking machine comprising a browser operating in a computer, and a sheet dispenser mechanism in operative connection with the computer. The sheet dispenser mechanism is operative responsive to receipt of at least one HTML format document by the browser, to dispense at least one sheet.

The Action (page 3) alleges that an ATM in LA Times "is considered to perform all the banking functions of a typical ATM, such as account access, transfer funds, dispense cash, dispense receipts, dispense statements, etc. The Citibank ATM is also considered to possess all the normal components and component interrelationships of an ATM machine such as a card reader, currency output device and a currency sheet dispenser, a receipt output device including a receipt sheet dispenser, etc., and a computer in operative connection with the output devices and the currency sheet dispensers, these ATM components being inherent." The Appellants respectfully disagree.

The banking functions in LA Times that the ATM is "considered to perform" and the components that the ATM is "considered to possess" are pure speculation by the Office. LA Times is silent as to the available banking functions and components included with the ATM. For example, where does LA Times specifically teach that the ATM is able to provide account access, transfer funds, and dispense statements, especially in 1994?

Appellants respectfully disagree that the alleged ATM components are inherent in LA Times. Anticipation by inherency requires that the Office establish that persons skilled in the art would recognize that the missing components are necessarily present in the LA Times reference. To establish inherency the Office must prove through citation to prior art that the features alleged to be inherent are "necessarily present" in LA Times. However, there is no teaching or suggestion in LA Times that the ATM is able to provide account access, transfer funds, and dispense statements. Nor has the Office proved that every ATM is able to provide account access, transfer funds, and dispense statements. That is, the Office has not proved through citation to prior art that the alleged features are "necessarily present" in LA Times. Inherency may not be established based on probabilities or possibilities (which is the present situation). It is plainly improper to reject a claim based merely on the (speculative) possibility that a particular prior art disclosure could or might be used or operated in the manner recited in the claim. *In re Robertson*, 169 F.3d 743, 49 U.S.P.Q. 2d 1949 (Fed. Cir. 1999).

Nor has the Action established in the prior art what constitutes the alleged "normal components" or "a typical ATM." Nor is there any teaching or suggestion that an ATM in LA Times is "a typical ATM", as alleged. The Office has not provided any evidence of record that a "typical" ATM in 1994 required the alleged features (e.g., dispense statements). Contrarily, LA Times specifically teaches that the ATM is "specially designed" (i.e., atypical). The limited locations (and thus quantity) of the ATMs also points to their uniqueness. Thus, in light of Appellants' contrary showing, the assertion that LA Times has "a typical ATM" with "normal components" is not legally appropriate.



The Action's assertions are not based on any evidence in the record. An assertion of knowledge not based on any evidence in the record lacks substantial evidence support. *In re Zurko*, supra. The determination of patentability must be based on evidence of record. *In re Lee*, supra. Appellants respectfully submit that because the rejection is based on mere assertions and not proper evidence of record, it is not a valid rejection.

The Action (on page 4) admits that LA Times does not teach or suggest the user interface at the ATM being a web browser interface. That is, the Action admits that LA Times does not teach or suggest an ATM having a browser. The Appellants respectfully submit that LA Times also does not teach or suggest an ATM that is able to receive HTML format documents. Contrarily, the limited geographical locations of the ATMs in LA Times appear to point to the system as being locally based with conventional prior art communications and programming rather than Web-based. Nor is there any teaching or suggestion in LA Times that an ATM needs or could operate with a browser. Additionally, the device described in LA Times distinguishes and keeps separate the brokerage services from the banking services. Furthermore, even if it were somehow possible for the brokerage services side to receive HTML format documents (which it isn't), there would still be no teaching or suggestion of an automated banking machine sheet dispenser mechanism being operative, responsive to receipt of at least one HTML format document by a browser, to dispense at least one sheet from the machine.

The Action alleges that in Infoworld a "browser interface is the interface through which all the ATM banking functions of the NCR ATM machine are performed, such as account access, funds transfer, the dispensing of currency and receipts responsive to the interaction of the user with the web browser interface." The Appellants respectfully disagree.

Where does Infoworld teach or suggest such features? For example, where does Infoworld teach or suggest that all the ATM banking functions are performed through a browser interface? Where does Infoworld teach or suggest that Top End carries out and controls the ATM transactions? Rather, Infoworld, as best understood, is directed to a TP monitoring program that monitors or tracks a transaction. Apparently, Top End (similar to present day TP monitors) ensures that each monitored transaction gets completed or rolled back. Note the above description of the Infoworld reference. Infoworld also admits that Web standards like CGI cannot handle Top End class applications (page 1, second to last paragraph).

Infoworld teaches that Top End is also applicable to cash registers in the same manner as it is applicable to ATMs. Where does Infoworld teach or suggest that Top End controls cash registers? If a cash register cannot be controlled by Top End then neither can an ATM.

Appellants respectfully submit that the Action takes the Infoworld language out of context. Infoworld does not state that it enables ATM transactions over the Web to make one or 10,000 machines look as if they are local to a computing resource, as alleged in the Action. Contrarily, Infoworld teaches that the "one or 10,000 machines" comment is directed to the Top End program reporting transactions to a back-end accounting system. Infoworld admits that NCR is still "trying to overcome" limitations "to enable" transactions over the Web. Thus, Infoworld is not capable of carrying out ATM transactions over the Web.

Furthermore, the system described in Infoworld describes credit card transactions being controlled and performed through a conventional proprietary transaction network (without a browser), with the account balancing transfers being monitored and reported to a back office system. The browser resides remotely from the ATMs and cash registers at the back office

system. Where does Infoworld teach that Top End requires use of a browser operating at an ATM or cash register?

Nor is there any teaching or suggestion in Infoworld of a sheet dispenser mechanism being operative, responsive to receipt of at least one HTML format document by a browser, to dispense at least one sheet from an automated banking machine. Where does Infoworld relate or link dispensing with an HTML document? Where does Infoworld teach or suggest receiving an HTML document with an ATM or cash register? Again, the Office wrongfully relies on pure speculation as the only basis for the allegations, instead of an actual teaching or suggestion in the applied reference. *In re Zurko*, supra.

The Action alleges that Anderson discloses a system for on-line financial services. The Action further alleges that Anderson's system comprises an internet browser interface, specifically a hyper-text mark-up language web browser.

As previously discussed, Anderson's system works to provide timely financial information to PC users, including users located anywhere (col. 3, line 61). The system permits users to review or check activity and balances relating to their accounts. Anderson's simple service (col. 5, lines 48-50) appears limited to enabling a user to merely check or verify their bill payments, without enabling a user to actually perform a banking transaction such as dispensing a currency sheet. Anderson's system is used with a customer's personal computer (col. 1, lines 52-54). It is unclear how Anderson is analogous to the recited automated banking machine which comprises a sheet dispenser mechanism that is operative, responsive to receipt of at least one HTML format document by the browser, to dispense at least one sheet from the automated banking machine.

The Action proceeds to allege that it would have been obvious (in view of either Infoworld or Anderson) to provide the LA Times ATM with a web browser interface. The reason provided in the Action is to enable the ATM user to perform all the typical ATM functions, including transactions over the web and dispensing currency sheets through the output devices. Appellants respectfully submit that the relied upon reason is without merit because none of the applied references teach, suggest, or provide motivation for enabling an ATM to perform all ATM transactions over the web, including transactions dispensing currency sheets, as alleged. As previously discussed, each specific reference lacks the ability to perform the ATM transactions over the web. The Action admits this deficiency in the LA Times article. As previously discussed, Infoworld is limited to transaction monitoring, and is likewise applicable to monitoring cash register transactions. As previously discussed, Anderson's system is limited to enabling simple services such as checking account balances with a customer's PC. Again, none of these references teach or suggest the alleged ability to perform all ATM transactions (including dispensing currency) over the web. It follows that the references combined also cannot teach or suggest the alleged ability to dispense a sheet in response to instructions in an HTML document. Furthermore, none of the applied references even teach or suggest (or mention) an ATM with a sheet dispenser mechanism, as alleged.

The Action further relies on an allegation of Official notice regarding the "fact" that it is well known (in the art of sheet feeders) that documents which are processed by the controlling web browser interface of a "particular" sheet feeding machine contain instructions for controlling the output devices of the machine, such as dispense instructions for feeding sheets through the

output devices of the machine. The Action further alleges that such an arrangement provides an effective and reliable control system for the output devices of the machine.

The Appellants respectfully disagree. First, claim 31 recites a "sheet dispenser mechanism" not a "sheet feeding machine" as alleged. Nevertheless, the Appellants continue to challenge the assertions of "Official notice." Where is the prior art teaching of the alleged "fact"? This Application claims priority back to November 27, 1996. Where is the evidence of record of a prior art teaching of HTML documents containing dispense instructions for feeding sheets through output devices of a machine, especially an automated banking machine? After five non-final rejections the Office still hasn't produced any prior art evidence that supports this assertion. How many more non-final rejections does the Office intend to give before it ceases searching for the ever elusive alleged prior art teaching? The present evidence of record does not teach or suggest the recited features in claim 31. The rejection relies on conclusory statements, not evidence of record. The Action's mere assertions do not constitute the required prior art evidence of record and thus lack substantial evidence support. The determination of patentability must be based on evidence of record, not on unsubstantiated assertions under the guise of an Official notice (which is the present situation). As the evidence of record does not support the rejection, the claims should be allowed. *In re Zurko*, supra. *In re Lee*, supra. MPEP § 2144.03.

Furthermore, in order to establish *prima facie* obviousness it must be shown that all the elements and relationships recited in the claim are known in the prior art. As Appellants have shown, the Office does not factually support any *prima facie* conclusion of obviousness. The Appellants are not required to prove patentability. On the contrary, it is the Office which must

establish a *prima facie* case of obviousness under the law. Otherwise, in the absence of any other valid rejection (which is the present situation), the Office is legally required to issue a patent.

The Action (on page 5) still further relies on another allegation of "Official notice" asserting that it is "well known" that the documents (containing instructions) in the aforementioned allegation of Official notice are "often" HTML documents/pages. That is, the rejection relies on an unsupported allegation based on other unsupported allegations. However, as previously discussed, a valid rejection involving Official notice must be based on evidence of record. Where does the evidence of record relate sheet dispensing to an HTML document? Where does the evidence of record relate operation of an automated banking machine sheet dispenser mechanism to an HTML document?

A famous commercial once set forth the question "Where's the beef?" So it is with the present rejection. Where's the prior art evidence of record supporting the rejections? There isn't any. Appellants have shown that a *prima facie* case of obviousness has not been established because the relied upon references do not teach or suggest all of the claim features and relationships. The Office has not met the burden of establishing *prima facie* obviousness. It follows that the rejection is not legally valid.

The Action is silent as to how the LA Times teaching could be modified by the teachings of either Infoworld or Anderson. Nor has any evidence been presented that LA Times is structurally and functionally capable of being modified as set forth by the teaching of either Infoworld or Anderson, especially to produce the recited invention. For example, the Action has not shown that NCR's alleged ATM technology (Infoworld) is compatibly interchangeable with Citibank's ATM technology (LA Times). Nor has the Action shown that Anderson's Conductor

system architecture is compatible with Citibank's ATM technology (LA Times). Nor has the Action presented a valid motivation to combine the references. Since the Action does not explain the rejection with reasonable specificity, it also procedurally fails to establish a *prima facie* case of obviousness. *Ex parte Blanc*, 13 USPQ2d 1383 (Bd. Pat. App. & Inter. 1989). Thus, it would not have been obvious to one having ordinary skill in the art to have modified LA Times with the teachings of either Infoworld or Anderson as alleged.

Furthermore, even if it were somehow possible to modify the system of LA Times with the teachings of either Infoworld or Anderson as alleged, such modification still would not have resulted in the recited features and relationships. The resulting modified disclosure of LA Times still would not teach or suggest an automated banking machine that is responsive to the receipt of an (at least one) HTML document to dispense a (at least one) sheet.

Even if it were somehow possible to modify the system of LA Times (1994) with the teaching of Infoworld it would have at best resulted in use of the Top End monitoring program with regard to an ATM. However, Infoworld (beginning in July 1996) already teaches use of Top End with regard to an ATM. Thus, modification (if somehow possible) of LA Times with the teachings of Infoworld would not have produced the recited invention. Thus, it would not have been obvious to one having ordinary skill in the art to have modified LA Times with the teachings of Infoworld to have produced the recited invention.

Even if it were somehow possible to modify the system of LA Times with the teachings of Anderson it would have at best resulted in providing simple services such as checking an account balance with a customer's PC. Thus, modification of LA Times with the teachings of Anderson would not have produced the recited invention. Thus, it would not have been obvious

to one having ordinary skill in the art to have modified LA Times with the teachings of Anderson to have produced the recited invention.

As previously discussed, none of the relied upon references even teach or suggest an automated banking machine sheet dispenser mechanism for dispensing a sheet. It follows that neither LA Times nor either Infoworld or Anderson, taken alone or in combination, teach or suggest an automated banking machine comprising a sheet dispenser mechanism that is operative, responsive to receipt of at least one HTML format document by a browser operating in the automated banking machine, to dispense at least one sheet from the automated banking machine. Not all of the recited features and relationships are taught or suggested by the applied references. However, to establish *prima facie* obviousness, it must be shown that all features and relationships recited in the claim are known in the prior art. Thus, the Office has not made a *prima facie* showing of obviousness. Appellants respectfully submit that the deficient nature of the references, and the lack of supporting evidence of record with regard to the Official notices, renders the rejection invalid.

The attempts to combine the alleged teachings are clearly attempts at hindsight reconstruction of Appellants' claimed invention, which is legally impermissible and does not constitute a valid basis for a finding of obviousness. *In re Fritch*, 22 USPQ2d 1780 (Fed. Cir. 1992). The rejections, which lack the necessary evidence and rationale, are based on knowledge gleaned only from Appellants' disclosure.

As previously discussed, none of the relied upon references, taken alone or in combination, disclose or suggest the features and relationships that are specifically recited in claim 31. Thus, a *prima facie* case of obviousness has not been established. Furthermore, as



previously discussed, it would not have been obvious to one having ordinary skill in the art to have combined the references as alleged. The applied prior art is devoid of any such teaching, suggestion, or motivation for combining features of the references so as to produce the recited invention. Nevertheless, as previously discussed, even if it were somehow possible for the references to be combined as alleged, the resultant combination still would not have resulted in the claimed invention. Therefore, Appellants respectfully submit that the 35 U.S.C. § 103(a) rejection should be withdrawn.

**Claim 35**

Claim 35 is directed to an automated banking machine comprising a browser operating in a computer, a card reader in operative connection with the computer, and a sheet dispenser mechanism in operative connection with the computer. The computer is operative responsive to reading indicia on a card with the card reader to cause the browser to receive at least one document. The computer is also operative responsive to receipt of at least one document by the browser, to enable the sheet dispenser mechanism to operate to dispense at least one sheet from the automated banking machine.

Appellants' remarks in support of the patentability of claim 31 are incorporated by reference as if fully rewritten herein. Furthermore, where do any of the applied references teach or suggest a card reader? It appears that the rejection of claim 35 only mentions "card reader" at Action page 4, line 1. The Action states that the ATM in LA Times is "considered" to possess a card reader. Thus, the Action, as best understood, relies on LA Times for teaching a card reader. However, there is no teaching or suggestion of a card reader in LA Times. The Office has not provided any evidence of record that a "typical" ATM in 1994 required a card reader. Nor has

the Office proved that LA Times' ATM has a card reader. That is, the Office has not proved through citation to prior art evidence of record that a card reader is "necessarily present" (i.e., inherent) in LA Times. Contrarily, as previously discussed, LA Times teaches a "specially designed" (i.e., atypical) ATM. LA Times teaches that other ways of providing input can be used with the "specially designed" ATM, such as by selecting a button or by touching a screen (to input a name or account number, for example). None of the applied references, taken alone or in combination, teach or suggest a card reader. *In re Zurko*, supra. *In re Lee*, supra. Nor has the Office established a *prima facie* showing of obviousness.

Also, even if somehow LA Times did teach a card reader the alleged combination of references still would not have produced the recited invention. None of the references teach or suggest that an automated banking machine computer is operative responsive to reading indicia on a card with a card reader to cause a browser to receive at least one document. Where do any of the references, taken alone or in combination, teach or suggest an interrelationship of reading card indicia and receiving a document? They don't, especially with regard to an automated banking machine. Thus, modification of LA Times with the teachings of either Infoworld or Anderson still would not have resulted in the recited invention.

Further, even if somehow LA Times did teach a card reader, none of the references teach or suggest that a computer is operative responsive to receipt of at least one document by a browser, to enable a sheet dispenser mechanism to operate to dispense at least one sheet from an automated banking machine. Where do any of the references relate receipt of at least one document by a browser to sheet dispenser mechanism operation? None of the references, taken alone or in combination, teach or suggest the recited interrelationship of a computer, browser,

card reader, and sheet dispenser mechanism of an automated banking machine. Thus, modification of LA Times with the teachings of either Infoworld or Anderson still would not have resulted in the recited invention.

Neither of the references, taken alone or in combination, teach or suggest all of the recited features and relationships, as is required to sustain the rejection. As previously discussed, the Official notice allegations lack substantial evidence support of record. The Action has not established a *prima facie* showing of obviousness. It would not have been obvious to one having ordinary skill in the art to have modified LA Times with the teachings of either Infoworld or Anderson to have produced the claimed invention. Therefore, Appellants respectfully submit that the 35 U.S.C. § 103(a) rejection should be withdrawn.

#### **Claim 38**

Claim 38 is directed to an automated banking machine comprising a computer including HTML document handling software, a card reader in operative connection with the computer, and a sheet dispenser in operative connection with the computer. The computer is operative responsive to reading indicia on a card with the card reader to cause the computer to operate to receive at least one HTML document. The computer is also operative responsive to the at least one HTML document to enable the sheet dispenser to dispense at least one sheet from the automated banking machine.

Appellants' remarks in support of the patentability of claim 35 (and claim 31) are incorporated by reference as if fully rewritten herein. As previously discussed, none of the references even teach or suggest a card reader. Furthermore, none of the references, taken alone or in combination, teach or suggest that an automated banking machine computer is operative

responsive to reading indicia on a card with a card reader to cause the computer to operate to receive at least one HTML document. Further, none of the references, taken alone or in combination, teach or suggest that a computer is operative responsive to the at least one HTML document to enable a sheet dispenser to dispense at least one sheet from an automated banking machine. It follows that none of the references, taken alone or in combination, teach or suggest an automated banking machine arrangement in which a computer is operative (responsive to the reading of card indicia) to receive at least one HTML document, and is further operative (responsive to the at least one HTML document) to enable a sheet dispenser to dispense a sheet from the machine. None of the references, taken alone or in combination, teach or suggest the recited interrelationship of a computer, HTML document handling software, card reader, and sheet dispenser of an automated banking machine. Nor do the references relate an automated banking machine card reader and an HTML document. Nor do the references, taken alone or in combination, teach or suggest an interrelationship involving reading card indicia, receiving at least one HTML document, and sheet dispensing.

The Action has not established a *prima facie* showing of obviousness. Neither of the references, taken alone or in combination, teach or suggest all of the recited features and relationships. Furthermore, as previously discussed, the Official notice allegations lack substantial evidence support of record. Thus, modification of LA Times with the teachings of either Infoworld or Anderson still would not have resulted in the recited invention. It follows that it would not have been obvious to one having ordinary skill in the art to have modified LA Times with the teachings of either Infoworld or Anderson to have produced the recited invention. Appellants respectfully request that the 35 U.S.C. § 103(a) rejection be withdrawn.

#### **Claim 41**

Claim 41 is directed to an automated banking machine comprising a computer including document handling software, a card reader in operative connection with the computer, and a note dispenser in operative connection with the computer. The computer is operative responsive to indicia read with the card reader to receive at least one document. The computer is also operative to control the note dispenser in dispensing at least one note from the automated banking machine responsive to the at least one document.

Appellants' remarks in support of the patentability of claim 35 (and claim 31) are incorporated by reference as if fully rewritten herein. As previously discussed, none of the references even teach or suggest a card reader. Furthermore, none of the references, taken alone or in combination, teach or suggest an automated banking machine computer that is operative responsive to indicia read with a card reader to receive at least one document. Further, none of the references, taken alone or in combination, teach or suggest that the aforementioned automated banking machine computer is also operative to control a note dispenser in dispensing at least one note from an automated banking machine responsive to the at least one document. It follows that none of the references, taken alone or in combination, teach or suggest an automated banking machine computer that is operative to control a note dispenser in dispensing at least one note from the machine responsive to at least one document received by the computer (responsive to indicia read with a card reader). The references, taken alone or in combination, do not teach or suggest the recited relationship of note dispenser control and a received document. Nor do the references, taken alone or in combination, teach or suggest an interrelationship involving reading indicia, receiving at least one document, and a note dispenser dispensing. None of the

references, taken alone or in combination, teach or suggest the recited interrelationship of a computer, document handling software, card reader, and note dispenser of an automated banking machine.

Neither of the references, taken alone or in combination, teach or suggest the recited features and relationships. As previously discussed, the Official notice allegations lack substantial evidence support of record. The Action has not established a *prima facie* showing of obviousness. It would not have been obvious to one having ordinary skill in the art to have modified LA Times with the teachings of either Infoworld or Anderson to have produced the recited invention. Nor would the modification have resulted in the recited invention. Appellants respectfully request that the 35 U.S.C. § 103(a) rejection be withdrawn.

#### **Claim 44**

Claim 44 is directed to an automated banking machine comprising a note dispenser mechanism, where the note dispenser mechanism is adapted to selectively dispense notes from the machine. A computer is in operative connection with the note dispenser. The computer is adapted to receive mark up language documents. The computer is also adapted to operate responsive to at least one mark up language document to cause at least one note to be dispensed from the banking machine.

Appellants' remarks in support of the patentability of claim 41 (and claims 31 and 35) are incorporated by reference as if fully rewritten herein. Additionally, none of the applied references, taken alone or in combination, teach or suggest a relation between at least one mark up language document and note dispensing. None of the references, taken alone or in combination, teach or suggest the ability to cause the dispense of a bank note from an automated

banking machine responsive to at least one mark up language document. It follows that none of the references, taken alone or in combination, teach or suggest an automated banking machine computer that is adapted to receive mark up language documents, and is also adapted to operate responsive to a mark up language document to cause at least one note to be dispensed from the machine. Neither of the references, taken alone or in combination, teach or suggest all of the recited features and relationships. Furthermore, as previously discussed, the Official notice allegations lack substantial evidence support of record.

The Action has not established a *prima facie* showing of obviousness. It would not have been obvious to one having ordinary skill in the art to have modified LA Times with the teachings of either Infoworld or Anderson to have produced the recited invention. Therefore, Appellants respectfully submit that the 35 U.S.C. § 103(a) rejection should be withdrawn.

**Claim 45**

Claim 45 depends from claim 44 and further recites a card reader in operative connection with the automated banking machine computer. The computer is adapted to operate responsive to indicia read by the card reader to cause the computer to receive the at least one mark up language document. As previously discussed (claim 44), the computer is adapted to operate responsive to at least one mark up language document to cause at least one note to be dispensed from the machine.

As previously discussed, none of the references even teach or suggest a card reader. None of the references, taken alone or in combination, teach or suggest the recited relationships among a card reader, indicia, at least one mark up language document, and computer. The references, taken alone or in combination, do not teach or suggest an automated banking machine

computer that is adapted to operate responsive to indicia read by the card reader to cause the computer to receive the at least one mark up language document. Furthermore, none of the references, taken alone or in combination, teach or suggest any relation between at least one mark up language document and note dispensing. The Action has not established a *prima facie* showing of obviousness.

The Acton (on page 6) again alleges that LA Times has a typical ATM. The Appellants respectfully disagree. As previously discussed (e.g., claim 31 remarks), LA Times teaches a "specially designed" (i.e., atypical) ATM. Nor has the Office provided any evidence of record that a "typical" ATM in 1994 required a card reader. *In re Zurko*, supra. Nor is there any teaching or suggestion that the LA Times (Citibank) ATM has or needs a browser. Even if it were somehow possible for the Citibank ATM to have a browser, there would still be no teaching or suggestion that the browser "would open web pages related to the user, the web pages having previously determined addresses and performing different transactional and informational functions as required by the user" as alleged. Regardless, even if it were somehow possible for the Citibank ATM to have a browser, there would still be no teaching or suggestion of an automated banking machine computer that is adapted to operate responsive to indicia read by the card reader to cause the computer to receive the at least one mark up language document. That is, the alleged modification of LA Times still would not have produced a relationship or link between card indicia and receiving a mark up language document. Thus, it would not have been obvious to one having ordinary skill in the art to have modified LA Times as alleged to have produced the recited invention.



### **Claims 48-50**

Appellants bring to the Board's attention that claims 48-50 each include an obvious typographical error. In line 1 of each claim "method" should read "machine". It is noted that the Office (on numerous occasions) did not object to the claim language. Furthermore, the Office grouped these claims with the "machine" of Group III, instead of with the "method" of Group IV or V in the restriction requirement.

Appellants previously (e.g., in the Appeal Brief filed September 11, 2001 and in the Supplemental Appeal Brief filed March 7, 2002) authorized correction of these minor informalities by Examiner's amendment. The Office's continued lack of objection to the claim language (including the absence of a claim objection in the Action) has been taken as acknowledgment by the Office that these trivial matters will be handled later by Examiner's amendment.

### **Claim 48**

Claim 48 depends from claim 31 and further recites that an ATM sheet dispenser mechanism is operative responsive to receipt of at least one HTML format document by the browser to dispense at least one sheet from the ATM. As previously discussed, none of the references, taken alone or in combination, relate sheet dispensing to receipt of at least one HTML format document. It follows that none of the references, taken alone or in combination, relate dispensing of at least one sheet from an ATM to receipt of at least one HTML format document. It further follows that none of the references, taken alone or in combination, teach or suggest the recited ATM sheet dispenser mechanism. The Action has not established a *prima facie* showing of obviousness. It would not have been obvious to one having ordinary skill in the art to have

modified LA Times with the teachings of either Infoworld or Anderson to have produced the recited invention.

**Claim 49**

Claim 49 depends from claim 35 and further recites that an ATM computer is operative responsive to receipt of at least one document by the browser to enable an ATM sheet dispenser mechanism to operate to dispense at least one sheet from the ATM.

As previously discussed, none of the references, taken alone or in combination, relate sheet dispensing to receipt of at least one document by a browser. It follows that none of the references, taken alone or in combination, relate operation of an ATM sheet dispenser mechanism to receipt of at least one document by the browser. It further follows that none of the references, taken alone or in combination, teach or suggest the recited relationship of the computer and sheet dispenser mechanism of an ATM. Again, the Action has not established a *prima facie* showing of obviousness. Nor would it have been obvious to one having ordinary skill in the art to have modified LA Times with the teachings of either Infoworld or Anderson to have produced the recited invention.

**Claim 50**

Claim 50 depends from claim 38 and further recites that an ATM computer is operative responsive to at least one HTML document to enable an ATM sheet dispenser to dispense at least one sheet from the ATM.

As previously discussed, none of the references, taken alone or in combination, relate sheet dispensing to an HTML document. It follows that none of the references, taken alone or in combination, teach or suggest an ATM computer that is operative responsive to at least one

HTML document to enable an ATM sheet dispenser to dispense at least one sheet from the ATM. It further follows that none of the references, taken alone or in combination, teach or suggest the recited relationship of the computer and sheet dispenser mechanism of an ATM. The Action has not established a *prima facie* showing of obviousness. Nor would it have been obvious to one having ordinary skill in the art to have modified LA Times with the teachings of either Infoworld or Anderson to have produced the recited invention.

#### **Claim 51**

Claim 51 is directed to an automated banking machine comprising a computer that is adapted to receive at least one mark up language document. The computer is adapted to operate responsive to the at least one mark up language document to cause at least one sheet to be dispensed from the automated banking machine.

Appellants' remarks in support of the patentability of claims 31 and 44 are incorporated by reference as if fully rewritten herein. As previously discussed, in none of the references, taken alone or in combination, is there any teaching or suggestion of a relationship between a mark up language document and sheet dispensing. Nor do any of the references, taken alone or in combination, teach or suggest the capability of dispensing a sheet responsive to at least one mark up language document. It follows that none of the references, taken alone or in combination, teach or suggest an automated banking machine computer that can receive at least one mark up language document and operate, responsive to the at least one mark up language document, to cause at least one sheet to be dispensed from the machine.

Neither of the references, taken alone or in combination, teach or suggest the recited features and relationships. As previously discussed, the Official notice allegations lack

substantial evidence support of record. The Action has not established a *prima facie* showing of obviousness. It would not have been obvious to one having ordinary skill in the art to have modified LA Times with the teachings of either Infoworld or Anderson to have produced the recited invention. Therefore, Appellants respectfully request that the 35 U.S.C. § 103(a) rejection be withdrawn.

#### **Claim 52**

Claim 52 depends from claim 51 and further recites that the sheet comprises a note. As previously discussed (e.g., claim 44), the applied references (or the Official notice) taken alone or in combination, do not teach or suggest a relationship between at least one mark up language document and note dispensing. None of the references, taken alone or in combination, teach or suggest an automated banking machine computer capable of causing at least one note to be dispensed from the machine responsive to at least one mark up language document. The Action has not established a *prima facie* showing of obviousness.

#### **Claim 53**

Claim 53 depends from claim 52 and further recites that the note comprises cash. None of the references, taken alone or in combination, teach or suggest a relationship between at least one mark up language document and cash dispensing. None of the references, taken alone or in combination, teach or suggest the capability of dispensing cash responsive to at least one mark up language document. None of the references, taken alone or in combination, teach or suggest an automated banking machine computer capable of causing cash to be dispensed from the machine responsive to at least one mark up language document.

Nor has the Office proved through citation to prior art evidence of record that "all ATM's have a currency note dispenser device" as alleged in the Action (on page 6). Again, the Action has not established a *prima facie* showing of obviousness.

#### **Claim 54**

Claim 54 depends from claim 53 and further recites an ATM computer that is adapted to operate responsive to at least one mark up language document to cause cash to be dispensed from the ATM.

None of the references, taken alone or in combination, teach or suggest a relationship between at least one mark up language document and ATM cash dispensing. None of the references, taken alone or in combination, teach or suggest the capability of dispensing cash from an ATM responsive to at least one mark up language document. It follows that the references, taken alone or in combination, do not teach an ATM computer that is adapted to operate responsive to at least one mark up language document to cause cash to be dispensed from the ATM. It further follows that none of the references, taken alone or in combination, teach or suggest an ATM computer that can receive at least one mark up language document and operate, responsive to the at least one mark up language document, to cause cash to be dispensed from the ATM. Also, the Office has not provided any supporting prior art evidence of record regarding the allegation (Action page 6) that "all ATM's have a currency note dispenser device."

The Action has not established a *prima facie* showing of obviousness. Nor would it have been obvious to one having ordinary skill in the art to have modified LA Times with the teachings of either Infoworld or Anderson to have produced the recited invention.

## CONCLUSION

Each of Appellants' claims specifically recites features and relationships that are neither disclosed nor suggested in any of the applied art. Furthermore, the applied art is devoid of any teaching, suggestion, or motivation for combining features of the applied art so as to produce the recited invention. For these reasons it is respectfully submitted that all the claims are allowable.

Respectfully submitted,



Ralph E. Jocke

Reg. No. 31,029

WALKER & JOCKE

231 South Broadway

Medina, Ohio 44256

(330) 721-0000

## **APPENDIX A CLAIMS ON APPEAL**

31. An automated banking machine comprising:

a computer;

a browser operating in the computer;

a sheet dispenser mechanism in operative connection with the computer, wherein the sheet dispenser mechanism is operative responsive to receipt of at least one HTML format document by the browser, to dispense at least one sheet from the automated banking machine.

35. An automated banking machine comprising:

a computer;

a browser operating in the computer;

a card reader in operative connection with the computer;

a sheet dispenser mechanism in operative connection with the computer, wherein the computer is operative responsive to reading indicia on a card with the card reader to cause the browser to receive at least one document, and wherein the computer is operative responsive to receipt of at least one document by the browser, to enable the sheet dispenser mechanism to operate to dispense at least one sheet from the automated banking machine.

38. An automated banking machine comprising:

a computer including HTML document handling software operating in the computer;

a card reader in operative connection with the computer;

a sheet dispenser in operative connection with the computer, wherein the computer is operative responsive to reading indicia on a card with the card reader to cause the computer to operate to receive at least one HTML document, and wherein the computer is operative responsive to the at least one HTML document to enable the sheet dispenser to dispense at least one sheet from the automated banking machine.

41. An automated banking machine comprising:



a computer, the computer including document handling software operating therein;

a card reader in operative connection with the computer;

a note dispenser in operative connection with the computer, wherein the computer is operative responsive to indicia read with the card reader to receive at least one document, and wherein the computer is operative to control the note dispenser in dispensing at least one note from the automated banking machine responsive to the at least one document.

44. An automated banking machine comprising:

a note dispenser mechanism, wherein the note dispenser mechanism is adapted to selectively dispense notes from the banking machine;

a computer in operative connection with the note dispenser, wherein the computer is adapted to receive mark up language documents, and wherein the computer is adapted to operate responsive to at least one mark up language document to cause at least one note to be dispensed from the banking machine.

45. The automated banking machine according to claim 44 and further comprising a card reader in operative connection with the computer, wherein the computer is adapted to operate responsive to indicia read by the card reader to cause the computer to receive the at least one mark up language document.

48. The method according to claim 31 wherein the automated banking machine comprises an Automated Teller Machine (ATM), wherein the sheet dispenser mechanism is operative responsive to receipt of at least one HTML format document by the browser to dispense at least one sheet from the ATM.

49. The method according to claim 35 wherein the automated banking machine comprises an Automated Teller Machine (ATM), wherein the computer is operative responsive to receipt of at least one document by the browser to enable the sheet dispenser mechanism to operate to dispense at least one sheet from the ATM.

50. The method according to claim 38 wherein the automated banking machine comprises an Automated Teller Machine (ATM), and wherein the computer is operative responsive to the at least one HTML document to enable the sheet dispenser to dispense at least one sheet from the ATM.

51. An automated banking machine comprising:

a computer, wherein the computer is adapted to receive at least one mark up language document, and wherein the computer is adapted to operate responsive to the at least one mark up language document to cause at least one sheet to be dispensed from the automated banking machine.

52. The automated banking machine according to claim 51 wherein the sheet comprises a note, and wherein the computer is adapted to operate responsive to the at least one mark up language document to cause at least one note to be dispensed from the automated banking machine.

53. The automated banking machine according to claim 52 wherein the note comprises cash, and wherein the computer is adapted to operate responsive to the at least one mark up language document to cause cash to be dispensed from the automated banking machine.

54. The automated banking machine according to claim 53 wherein the automated banking machine comprises an Automated Teller Machine (ATM), and wherein the computer is adapted to operate responsive to the at least one mark up language document to cause cash to be dispensed from the ATM.

## **APPENDIX B**

### **NON ELECTED WITHDRAWN CLAIMS**

1. Apparatus comprising:

a banking machine, including:

an output device, wherein such output device outputs information to a user;

an input device, wherein a user is enabled to input messages to said machine;

a sheet dispenser mechanism;

a computer, wherein said computer is in operative connection with the output device, the input device and the sheet dispenser mechanism;

software executable in said computer, said software including:

an HTML document handling portion in operative connection with the input device and the output device,

wherein said HTML document handling portion is  
operative to receive HTML format documents;

a device application portion in operative interfacing relation  
with the HTML document handling portion, wherein said  
device application portion is in operative connection with  
the sheet dispenser, and wherein said device application  
portion is operative responsive to the HTML document  
handling portion receiving an HTML format document  
including a dispense instruction to cause the sheet dispenser  
mechanism to dispense at least one sheet.

2. Apparatus comprising:

a banking machine, including:

an output device, wherein the output device outputs information to a  
user;

a card reader, wherein the card reader is operative to read a card including  
indicia thereon, and wherein the indicia corresponds to a system address  
associated with the user;

a sheet dispenser mechanism;

a computer, wherein the computer is in operative connection with the output device, the card reader and the sheet dispenser mechanism;

software executable in the computer, the software including:

an HTML document handling portion, wherein the HTML document handling portion is operative to cause a message to be generated to the system address responsive to the indicia, and to receive HTML format documents; and

a device application portion in operative interfacing relation with the HTML document handling portion, wherein the device application portion is operative responsive to the HTML document handling portion receiving a dispense instruction in an HTML format document, to enable the sheet dispenser mechanism to dispense at least one sheet.

3. The apparatus according to claim 2 wherein the system address for the user includes a URL address.

4. The apparatus according to claim 1 wherein in said banking machine said HTML document handling portion and said device application portion both communicate messages through TCP/IP, and wherein said HTML document handling portion communicates at a first IP port and said device application portion communicates at a second IP port.
5. The apparatus according to claim 4 wherein the software in the banking machine further comprises a device interfacing software portion, and wherein said device interfacing software portion is operative to interface with said sheet dispenser mechanism, wherein said application portion interfaces with said sheet dispenser mechanism through said device interfacing software portion, and wherein said device interfacing software portion communicates at a third IP port.
6. The apparatus according to claim 1 wherein said HTML document handling portion includes a browser.
7. The apparatus according to claim 1 wherein said dispense instruction is an embedded instruction.
8. The apparatus according to claim 1 wherein said dispense instruction is in JAVA script.
9. The apparatus according to claim 1 wherein said device application portion includes a first applet, wherein said first applet is operative to cause operation of said sheet dispenser mechanism.

10. The apparatus according to claim 1 wherein said banking machine further comprises a printer mechanism, wherein said printer mechanism is in operative connection with said computer, and wherein said printer mechanism is operative responsive to the device application portion of the software, and wherein said printer mechanism is operative to print responsive to receipt of a print instruction by said HTML document handling portion.

11. The apparatus according to claim 1 wherein said banking machine further comprises at least one device, said device being one of a printer mechanism, a card reader mechanism or a depository mechanism, and wherein said device is operative responsive to the device application portion of the software, and wherein the device is operative responsive to receipt of a device instruction by the HTML document handling portion.

12. The apparatus according to claim 1 wherein said dispenser mechanism is operative responsive to dispensing said sheets to cause a dispenser operation message to be delivered to the device application portion of the software, and wherein said HTML document handling portion is operative responsive to delivery of the dispenser operation message to output a dispense response message from said HTML document handling portion.

13. The apparatus according to claim 11 wherein the device is operative responsive to its operation to cause a device operation message to be delivered to the device application portion of the software, and wherein the HTML document handling portion is operative responsive to the delivery of the device operation message to output a device response message from the HTML



document handling portion.

14. The apparatus according to claim 12 wherein the HTML document including the dispense instruction includes a response instruction, wherein said response instruction is operative to cause the output of the dispense response message responsive to delivery of the dispense operation message to the device application portion of the software.

15. The apparatus according to claim 1 and wherein said banking machine further comprises a plurality of devices, said devices operative responsive to the device application portion of the software, and wherein said device application portion includes at least one applet operative to control at least one of said plurality of devices.

16. The apparatus according to claim 15 and wherein said software further comprises a device interfacing software portion operative to interface with said devices, and wherein said device interfacing software portion includes a device program operative to interface with said one applet.

17. The apparatus according to claim 16 wherein said applet is operative to communicate through a second IP port and the device program is operative to communicate through a third IP port.

18. The apparatus according to claim 1 and further comprising a home HTTP server in operative connection with the HTML document handling portion of the banking machine, and wherein the home HTTP server is operative to send HTML documents to the HTML document handling portion of the software in the banking machine.

19. The apparatus according to claim 18 wherein the home HTTP server is operative to send the dispense instruction to the banking machine.

20. The apparatus according to claim 18 wherein the home HTTP server includes a home address, and wherein the HTML document handling portion of the software is operative to send a message to the home address in response to a user input at said input device.

21. Apparatus comprising:

a home http server having a home address; and

a banking machine, including:

an output device, wherein the output device outputs information to a user;

a card reader operative to read card indicia on a card input by a user;

a sheet dispenser mechanism;

a computer, wherein the computer is in operative connection with the output device, the card reader and the sheet dispenser mechanism;

software executable in the computer, the software including:

an HTML document handling portion, wherein the HTML document handling portion is operative to cause the computer to send a message to the home http server responsive to the card indicia corresponding to the home address, and to receive HTML format documents; and

a device application portion in operative interfacing relation with HTML document handling portion, wherein the device application portion is operative responsive to the HTML document handling portion receiving a dispense instruction in an HTML format document, to enable the sheet dispenser mechanism to dispense at least one sheet.

22. The apparatus according to claim 21 wherein said card indicia further corresponds to identifying information associated with a file, wherein said file is associated with the user, and wherein said file is stored in operative connection with the home HTTP server.

23. The apparatus according to claim 22 wherein said card indicia includes a URL address associated with the user.

24. The apparatus according to claim 22 wherein the file includes at least one HTML document associated with the user.

25. The apparatus according to claim 18 and further comprising a proxy server in operative connection with the home HTTP server, wherein the home HTTP server has a home address, and said HTML document handling portion has a machine address, and wherein said proxy server is operative to direct messages from said banking machine to the home HTTP server responsive to said messages including the home address.

26. The apparatus according to claim 25 wherein the proxy server is also in operative connection with a wide area network, and wherein said wide area network includes a foreign server, wherein said foreign server has a foreign address, and wherein said banking machine further includes an address input device in operative connection with the HTML document handling portion, and wherein the HTML document handling portion is operative responsive to input of the foreign address through said address input device to generate a foreign message addressed to the foreign address, and wherein said proxy server is operative responsive to receipt of the foreign address to pass the foreign message to said wide area network

27. The apparatus according to claim 26 wherein said proxy server includes screening software, wherein said screening software is operative to prevent the sending of the foreign message to at least one selected foreign address.

28. The apparatus according to claim 26 wherein said proxy server is operative responsive to receiving a foreign response message from said foreign address directed to said machine address to pass the message to said HTML document handling portion of the software in said banking machine.

29. The apparatus according to claim 5 and further comprising a device server, wherein said device application portion of said software and said device interfacing software portion communicate through said device server.

30. The apparatus according to claim 29 wherein said device server includes monitor software, wherein said monitor software is operative to limit operation of said sheet dispensing mechanism.

32. A method comprising the steps of:

- a) operating a browser in at least one computer in connection with an automated banking machine;

- b) receiving at least one HTML format document with the browser, wherein the HTML format document includes at least one dispense instruction;
- c) dispensing at least one sheet from a sheet dispenser in the automated banking machine responsive to receipt by the browser of the HTML format document including the dispense instruction.

33. The method according to claim 32 wherein the automated banking machine includes an output device in operative connection with the computer, and further comprising the step of:

- d) producing an output through the output device responsive to the receipt of the HTML format document by the browser.

34. A method comprising the steps of:

- a) operating a browser in at least one computer in connection with an automated banking machine;
- b) receiving at least one document with the browser, wherein the document includes at least one dispense instruction embedded therein;
- c) dispensing at least one sheet from a sheet dispenser in the automated

banking machine responsive to receipt by the browser of the document including the dispense instruction.

36. A method comprising the steps of:

- a) operating a browser in at least one computer in connection with an automated banking machine;
- b) reading indicia on a card input by a user to a card reader in connection with the automated banking machine;
- c) receiving at least one document with the browser responsive to the indicia read from the card, wherein the document includes at least one instruction;
- d) responsive to receipt by the browser of the document including the instruction in step (c), enabling a sheet dispenser in connection with the automated banking machine to operate to dispense at least one sheet.

37. A method comprising the steps of:

- a) operating a browser in at least one computer in connection with an automated banking machine;

- b) receiving at least one document with the computer, wherein the document includes at least one instruction therein;
- c) controlling a note dispenser in the automated banking machine responsive to receipt by the computer of the document including the instruction.

39. A method comprising the steps of:

- a) operating document handling software in at least one computer in connection with an automated banking machine, wherein the document handling software is operative to process HTML documents;
- b) reading indicia on a card input by a user to a card reader in connection with the automated banking machine;
- c) receiving at least one document with the computer responsive to the indicia read from the card, wherein the document includes at least one instruction;
- d) enabling the dispense of at least one sheet from a sheet dispenser in



connection with the automated banking machine responsive to the computer receiving the document including the instruction.

40. A method comprising the steps of:

- a) operating a HTML document handling software in at least one computer in connection with an automated banking machine;
- b) receiving at least one HTML document with the computer, wherein the HTML document includes at least one instruction therein;
- c) controlling the dispense of at least one note from the automated banking machine responsive to receipt by the computer of the HTML document including the instruction.

42. A method comprising the steps of:

- a) operating at least one computer in connection with an automated banking machine, wherein the computer has operating therein document handling software;

- b) receiving at least one document responsive to the operation of the computer, wherein the document includes at least one instruction therein;
- c) controlling dispense of at least one note from the automated banking machine responsive to the at least one instruction included in the document received in step (b).

43. A method comprising the steps of:

- a) reading indicia on a card input to a card reader of an automated banking machine;
- b) operating a computer in connection with the automated banking machine responsive to indicia read from the card in step (a), to cause a message to be generated to a system address;
- c) operating the computer to receive a document responsive to the message generated in step (b);
- d) operating the computer to control dispensing of at least one note from the banking machine responsive to the document

received in step (c).

46. A method comprising the steps of:

- a) operating at least one computer in an automated banking machine, wherein the computer is adapted to receive mark up language documents;
- b) operating the computer to receive at least one mark up language document;
- c) operating the computer responsive to the at least one mark up language document to cause at least one note to be dispensed from the banking machine.

47. The method according to claim 46 and prior to step (b) further comprising the step of:

reading indicia with a reading device in the machine, wherein the computer is operative responsive to the indicia to cause the computer to perform step (b).